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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

YOR920000385US1

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name \_\_\_\_\_

Application Number

09/652,159

Filed

08/31/2000

First Named Inventor

Te-Kai Liu

Art Unit

3627

Examiner

V. Frenel

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)☒

attorney or agent of record.

Registration number **32,635**☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_



Signature

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**April 24, 2007**

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.☐

\*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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YOR920000385US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of

Te-Kai Liu et al.

Confirmation No. 2619

Serial No. 09/652,159

Group Art Unit No. 3627

Filed August 31, 2000

Examiner Vanel Frenel

For ACCESS CONTROL FOR  
RENTAL CARS

Box AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

ATTACHMENT TO PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This Pre-Appeal Brief Request for Review is being concurrently filed in the USPTO with a Notice of Appeal. A check is attached to satisfy the fees for a Notice of Appeal. If any additional fees are required to satisfy the fees due for the Notice of Appeal or to gain entry and consideration of this Pre-Appeal Brief Request for Review, the Commissioner is authorized to charge Attorney's Deposit Account 50-2041.

*The Claimed Invention*

The claimed invention provides a rental car system in which cars are operated by digital keys instead of conventional keys and in which, among other things, there is no need for a data communication link between a rental car and a central station or for transaction-by-transaction reprogramming of a rental car's reader. Each car is capable of invalidating a digital key at the end of a rental period.

As shown in Figure 1, the claimed invention includes a computing system 10, a portable storage device 12, and an access control device 14 with an interface 16 to a portable storage inside a rental car 160. The computing system 10 is used to make reservations and to create and store the digital keys used to enable operation of a rental cars 160. The computing system 10 can connect to a central reservation server 110 via a network 120, which may be the Internet. The computing system 10 may be provided with a way to download a digital key to a portable storage device 12, which may take the form of a smart card issued by the car rental agency, a personal digital assistant, a memory card, or a diskette. The renter may bring a portable storage device 12 containing a digital key to a rental car 160 equipped with an access control device 14 capable of reading the digital key from the portable storage device 12 and, upon authentication of the digital key by the access control device, enable operation of the rental car 160. Upon return, the rental car 160 invalidates the digital key so that it no longer starts the car, and the renter may present the invalidated digital key to a central station of the car rental system. The digital key may be contained on a storage device provided by the renter rather than the car rental company. (Claims 6, 16; Specification, page 2, line 25, through page 3, line 2, and page 5, lines 10-15)

#### *Principal Errors and Omissions*

The claimed invention stands rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Application No. 20050261986 to Haynes et al. in view of U.S. Patent Application No. 20020013815 to Obradovich et al. The Examiner has made a great many errors and omissions, including, but not limited to, the following:

- The Examiner erroneously concluded that it is obvious to require, as does base claim 1, “wherein there exists no data communication link between the fleet of cars and the management system”, even though neither reference suggests that requirement.

- The Examiner erroneously concluded that it is obvious to require, as does base claim 11, a digital key making it possible “to gain access to a rental car without communication between the rental car and the reservation server”, even though neither reference suggest that requirement.

Regarding base claim 1, Applicants pointed out, in the November 13, 2006 response to the previous office action, that the requirement “wherein there exists no data communication link between the fleet of cars and the management system” (Claim 1, lines 9-10) (emphasis added) is inconsistent with the express teaching of the reference that “[t]he host computer transmits all of the E-card information to the automobile system in the subject vehicle via a wireless communications connection” (Obradovich et al., paragraph 106), which had been relied on by the Examiner in support of rejection. Rather than addressing this point, the Examiner simply asserts the opposite without explanation. (Office Action at 3, Paragraph B) It is, however, simply impossible for a reference that teaches “via a wireless communication connection” to suggest the requirement “wherein there exists no data communications link.”

Regarding base claim 11, the requirement “creating by the reservation server a digital key by car and user information with a digital signature of the reservation server” (Claim 11, lines 8-9) is not suggested by either Haynes et al. or Obradovich et al. Recognizing that Haynes et al. clearly do not suggest anything close to this requirement, the Examiner states the conclusion that Obradovich et al. makes up for the deficiency. In doing so, however, the Examiner fails to explain what it is in Obradovich that supports rejection. In the November 13, 2006 response to the previous office action, Applicants argued that the Examiner was relying on impermissible hindsight. In the current office action, the Examiner continues to apply impermissible hindsight. Here, the Examiner asserts “since the E-card [taught by Obradovich et al.] has been programmed and sensed therefore it can also disabled [sic] the key.” (Office Action at 4, Paragraph D) Not only is this explanation incoherent, but it fails to explain why the ability to program and sense an E-card suggests the use of the digital key of the claimed invention. In part the

Examiner's confusion may be based on a failure to appreciate that the E-card of Obradovich et al. is not analogous to the digital key of the claimed invention but is more analogous to a "portable storage device" on which a digital key may be stored.  
(Claim 11, line 10)

*Conclusion*

In view of the foregoing, it is clear that the Examiner has simply made a with respect to what is claimed in the Claims 1-20 and/or what is shown or not shown in the references. It is respectfully requested that Claims 1-20 be allowed and that the application be passed to issue.

Respectfully submitted,



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